

## REMARKS

### I. Office Action Summary

Claims 31-52 are pending. Claims 31, 36 and 43 are the independent claims. In the Office Action, all of the pending claims were rejected. Claims 31-33, 36, 38 and 40-41 were rejected as anticipated by Braecklein (US 1,671,010) under 35 U.S.C. §102(b). Claims 34-35, 37 and 39 as rejected as obvious over the following combinations of references:

| Rejected Claim | Prior Art Reference                |
|----------------|------------------------------------|
| 34, 37         | Braecklein + Benos (US 2,238,964)  |
| 35             | Braecklein + Blount (US 3,182,659) |
| 39             | Braecklein + Benos + Blount        |

Claims 33, 38-40 and 42-46 were rejected as indefinite under 35 U.S.C. §112, second paragraph. Finally, claims 42-52 were rejected over claims 1-13 of the issued parent case (US 5,988,160) for obviousness-type double patenting.

### II. Rejections Under 35 U.S.C. § 102(b)

#### Claim 31

Claim 31 relates to a mask for the inhalation of medication including, *inter alia*, a valve integrally formed with a wall of the mask. Braecklein discloses an inhaler mask adapted for inhalation of chlorine gas mixed with air. Both an inhalation valve and an exhalation valve are shown in Braecklein. These valves (identified by reference numerals 14 and 17) are described as having a removable perforated cap (15,18) within which a movable disk (16,19) is floating so that the disk seats or unseats against the end of the respective inhalation or exhalation conduit of the mask that the perforated cap is secured to (See Braecklein, page 1, lines 74-91).

Applicant notes the Examiner's statements regarding product-by-process claims. Applicant disagrees that the integrally molded valve element is a product by process claim element. Instead, Applicant submits that the element generally refers to a valve integral with the wall (as opposed to a removable valve). As the Examiner has raised some concerns with this language, Applicant has broadened claim 31 to make clear that no single process is intended to limit the valve that is integral with the mask.

Applicant respectfully submits that Braecklein does not teach or suggest an integral valve. Braecklein's disclosure only shows a multi-piece, removable valve and specifically states that the caps "may be removed and replaced when desired" – something impossible to do with an integral valve. Accordingly, Applicant respectfully submits that the § 102 rejection has been traversed. Claims 32-33 are dependent claims, therefore their allowability directly follows from the allowability of independent claim 31.

#### Claim 36

Although claim 36 differs in scope from claim 31, the arguments set forth above with respect to the lack of an integral valve in Braecklein apply equally to claim 36. The Examiner, in comments regarding claim 36, states that Braecklein discloses an exhalation valve integral with a wall of the mask. As discussed above, a removable valve is the only type of valve taught or suggested by Braecklein. The very nature of the only valve disclosed in Braecklein, that of a floating disk captured between the end of an opening in the mask and the removable, perforated cap, is clearly not integral and does not suggest an integral valve or how the disclosed valve even could be converted to an integral valve. Accordingly, for at least these reasons, Applicant submits that claim 36 is allowable over Braecklein. Claims 37-42 are dependent claims, therefore their allowability directly follows from the allowability of independent claim 36.

### **III. Rejections Under 35 U.S.C. § 103**

#### Claims 34 and 37

The Examiner rejected claims 34 and 37 over the combination of Braecklein and Benos. Braecklein, as discussed previously, fails to teach or suggest an integral valve. Benos, although disclosing a duckbill-type valve, also fails to show an integral valve and thus does not make up for the deficiencies of Braecklein. Applicant disagrees that there is any teaching or suggestion to combine the Braecklein and Benos references, and also disagrees that claim 34 and 37 are of similar scope. Accordingly, Applicant submits that claims 34 and 37 are allowable for at least the same reasons as provided for their respective independent claims (31 and 36).

#### Claim 35

Dependent claim 35 was rejected as obvious over the combination of Braecklein and Blount. Blount, as Braecklein, fails to teach or suggest an integral valve. Accordingly, for at least the same reasons as provided for independent claim 31, Applicant submits that claim 35 is in condition for allowance.

#### Claim 39

Dependent claim 39 was rejected as obvious over the combination of Braecklein, Benos and Blount. As well as including the features of claims 36 and 38, claim 39 recites the feature of exhalation valve movement being visible through a wall of an extension. Applicant submits that, in addition to lacking an integral valve (claim 36), the cited references fails to teach or suggest an extension in which the exhalation valve is recessed (claim 38). Accordingly, Applicant submits that claim 39 is allowable over the cited art.

### **IV. Rejections Under 35 U.S.C. § 112**

The term “tunnel-like” was objected to as making claims 33, 38-40 and 42-46 indefinite. Applicant respectfully disagrees and notes that the term clearly describes the disclosed extension shown, for example, in FIGS. 1-6. The mere fact that all possible versions of “tunnel-like” extensions are not shown in the

specification does not limit the ability of Applicant to claim this feature based on the version that is expressly shown. Applicant appreciates the Examiner's courtesy in offering a potential substitute for this language, however Applicant requests that that Examiner reconsider and withdraw this objection.

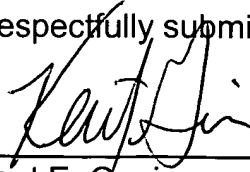
## **V. Rejections For Obviousness-type Double Patenting**

The Examiner rejected claims 42-51 for obviousness-type double patenting in view of claims 1-13 of U.S. Patent No. 5,988,160. Applicant respectfully disagrees with this rejection, however, in order to expedite allowance of this case, Applicant will supply a suitable terminal disclaimer upon indication of allowability of the remaining claims over the cited art.

## **VI. CONCLUSION**

Claims 43-46 have been amended to correct for consistency in the use of "said". Applicant submits that substitution of "said" for "the" does not narrow the scope of these claims and merely rectifies stylistic concerns. Claims 31-32 have been amended to broaden the language therein regarding the valve that is an integral part of the mask. In view of the amendments and remarks above, Applicant respectfully submits that all of the pending claims (31-52) are in condition for allowance. If any questions arise or issues remain, the Examiner is requested to contact the undersigned at the number listed below in order to expedite disposition of this case.

Respectfully submitted,



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